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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/886,516	07/01/1997	WILLIAM BERSON	E-621	8901

919 7590 05/12/2003

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EXAMINER

SMITHERS, MATTHEWS

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 05/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

84

## Office Action Summary

Application No.	08/886,516	Applicant(s)	BERSON ET AL.
Examiner	Matthew B Smithers	Art Unit	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 25 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-3,5-7,10 and 11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5-7,10 and 11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 8 and 9 were canceled.

Claims 1-3, 5-7 and 10-11 are pending.

### ***Response to Arguments***

Applicant's arguments filed February 25, 2003 have been fully considered but they are not persuasive. Applicant argues the prior art reference (Indeck) does not disclose or suggest a label as recited in applicant's independent claims. Examiner contends the reference does suggest a label in accordance with applicant's teaching of a label. More specifically, on page 3, lines 8-19 of the disclosure, applicant teaches a label includes a marking which is associated with the article and is likely to remain associated with the article through a period of interest. Indeck teaches a readable barcode (label) is recorded onto the article of interest (magnetic medium or tape) and a magnetic fingerprint (unreproducible pattern) is recorded within the barcode. The affixation of the barcode that contains the magnetic fingerprint onto the article forms a secure association in accordance with applicant's disclosure. Therefore, the examiner maintains the prior art rejection. See below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 5, 6, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,365,586 granted to Indeck et al.

The Indeck reference discloses a method and apparatus for fingerprinting magnetic media. This fingerprint may be affixed to an object of manufacture in order to verify and authenticate the object, see Abstract.

With respect to claim 1, step a, the label with unreplicable pattern is disclosed as column 6, lines 23-28;

step b, describing the unreplicable pattern and including the description with the information relating to the article at column 4, lines 30-35 and Figure 3;

step c, encrypting a portion of the information at column 2, lines 35-45; and

step d, securely associating the article, the label and a tangible representation of the encrypted information at column 3, lines 5-10.

With respect to claim 10, see Figure 3, and column 6, lines 23-28.

With respect to claim 11, see column 4, lines 35-38, which disclose the verifying step.

Claim 2, see column 4, lines 8-18.

Claim 3, see column 4, lines 24-40.

Claim 5, see column 3, lines 54-62.

Claim 6 is met by the description at column 4, lines 35-38.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,365,586 granted to Indeck et al and further in view of U.S. patent 5,638,446 granted to Rubin.

The Indeck patent discloses verification using the publicly known key at column 4, lines 35-38. However, the instant claims provide for signing of the public key by a trusted third party. The patent to Rubin teaches a secure distribution of electronic files. The files are signed by the source of the files (the authors) and the public key of the authors is signed with the secret key of a trusted third party, see Figure 2, blocks 30, 32, and 34. It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to sign the public key of the source as taught in Rubin in order to provide a public key of a source with the certification of a trusted third party.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
Matthew B Smithers  
Primary Examiner  
Art Unit 2134

May 7, 2003